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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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Townsend and Townsend + Crew
379 Lytton Ave.
Palo Alto CA 94301

EXAMINER	
ZANELLI, M	
ART UNIT	PAPER NUMBER
3661	7

DATE MAILED: Remail 1/7/98
~~11/10/98~~

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

see attached

Office Action Summary

Application No.

09/010,408

Applicant(s)

Shah et al

Examiner

M. Zanelli

Group Art Unit

3661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 8/11/98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 21-42 ~~is~~/are pending in the application.
- Of the above claim(s) 21-42 is/are withdrawn from consideration.
- ☐ Claim(s) 21-42 is/are allowed.
- ☒ Claim(s) 21-42 ~~is~~/are rejected.
- ☐ Claim(s) 21-42 is/are objected to.
- ☐ Claim(s) 21-42 are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The proposed drawing correction, filed on 8/11/98 is ☒ approved ☐ disapproved.
- ☐ The drawing(s) filed on 8/11/98 is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3661

DETAILED ACTION

1. This application is acknowledged as a Continuation of application no. 08/443063, filed 5/17/95. The preliminary amendment filed 8/11/98 has been entered. Claims 21-42 are pending.
2. It is noted that the filing receipt indicates that application no. 08/443063 is a Continuation of application 07/961736; however, records indicate that the '063 application is a Continuation-in-part of the '736 application. Applicant may wish to request a corrected filing receipt.
3. The proposed drawing correction filed 8/11/98 has been approved.
4. Claims 25, 26, 41, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - A. As per claims 25 and 26, the claims are vague as to what the maintenance system provides information about. Is this information relevant to the computer hardware/software of the database system or maintenance information regarding the mobile units?
 - B. As per claims 41 and 42, the claims as recited are unclear as to what is meant by "operable coupled". Perhaps applicant intended the claims to read "operably coupled" (see e.g. claim 21).

Art Unit: 3661

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 6 and 19 of U.S. Patent No. 5,428,546. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims encompass the subject matter now being claimed. The patented claims include three databases containing mobile unit information, raster information, and vector information which is processed by a means for interrelating the information. The application claims represent a subset (subcombination) of the overall tracking system. The application claims are further provisionally rejected under the

Art Unit: 3661

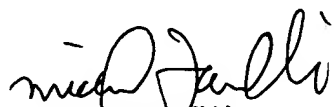
judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 1 and 13 of U.S. Patent No. 5,636,122 and at least claim 1 of U.S. Patent No. 5,594,650. Both of these patents claim subject matter which encompasses the database system now being claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Zanelli** whose telephone number is (703) 305-9756 (M-Th, 6:30-5:00 PM).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

/mjz
October 30, 1998


MICHAEL ZANELLI
PRIMARY EXAMINER